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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/709,978

06/10/2004

Lydia Breck

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FITZPATRICK CELLA (AMEX)  
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EXAMINER

NEWTON, JARED W

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

10/06/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/709,978	<b>Applicant(s)</b> BRECK ET AL.	
	<b>Examiner</b> JARED W. NEWTON	<b>Art Unit</b> 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/28/08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

This final rejection is in reply to the remarks filed June 23, 2008, by which claim 1 was amended, and claims 3-7 were added.

#### ***Information Disclosure Statement***

The Information Disclosure Statement (IDS) submitted on 7/28/2008 was filed after the mailing date of the non-final rejection on 1/23/2008. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the Information Disclosure Statement is being considered by the Examiner. The Examiner notes that some of the cited references, including US Patent No. 6,123,223 to Watkins, titled *Automated Vending System for Floral Arrangements*, US Patent No. 6,422,532 to Garner, titled *Severe Service Valve Positioner*, US patent No. 6,769,718 to Warther et al., titled *Printed Sheet Products*, US Patent No. 5,660,319 to Falcone et al., titled *Ultrasonic Bonding Process*, US Patent No. 4,475,308 to Heise et al., titled *Revolving Door System*, European Patent Application No. 0484726, titled *Packaging Material with Good Gas Barrier Properties and also Packaging Container Manufactured from the Material*, Japanese Patent Publication No. JP2000015288 titled *Waste Water Treatment Method and Apparatus*, a Toronto Star article by Judy Nyman titled *Free income tax clinics are opening as April 30 deadline draws near*, and a webpage from [www.bible-prophecy.com/revival.htm](http://www.bible-prophecy.com/revival.htm), do not appear relevant to the claimed invention, which is directed to a dispute handling method. Nevertheless, these references have been considered.

***Claim Objections***

Claim 3 is objected to because of the following informalities: the word “in” in line 2 should be changed to “at”. Appropriate correction is required.

Claim 7 is objected to because of the following informalities: the word “in” in line 2 should be changed to “at”. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular the Applicant has not provided support for the newly added limitations of claims 4-7. Upon a review of the disclosure as originally filed, the Examiner is unable to find adequate support for, inter alia, the following limitations: “requesting, by a merchant, that the provider return a secondary transaction number (STN) in lieu of returning the account number” (claim 4, lines 6-7); and “receiving, from the merchant, a request that a provider of the primary account return the STN in lieu of returning the primary account number” (claim 5, lines 8-9); and

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"retrieving transaction information from a database using the primary account number" (claim 5, lines 16-17).

In response to this rejection, the Applicant should cancel the noted claims and/or limitations, or provide specific reference to the specification as originally filed in order to support all of the newly added claims and/or limitations.

For purposes of examination, the Examiner has not considered the noted limitations.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,826,241 to Stein et al. (hereafter Stein).

In regard to claim 1, Stein discloses a method and payment system for facilitating secure financial transactions between two users (i.e. a merchant and a customer) over the internet, wherein a customer's financial and credit information are isolated from a front end portion of the payment system (see abstract), and wherein said method includes a dispute handling method for handling a disputed transaction involving a secondary transaction number 102, the method comprising the steps of:

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receiving a dispute from a first party (see col. 11, line 54 – col. 12, line 7) relating to a transaction involving a secondary transaction number 102 associated with a primary account, wherein the primary account includes a primary account number (see col. 5, lines 9-67 – Stein discloses “a cardholder account 100 includes at least the following information: a cardnumber 102 ... [L]ocated on the storage device 58 associated with the front end computer 50 is that portion of the subscriber account information 106 that includes the subscriber account number [102] ... However, the front end computer 50 does not contain any of the pay-in 108 or pay-out 110 information, such as credit card information, etc., associated with any of the subscribers. Credit card or other payment information is located only in the data file 114 on the storage device 72 of back end computer 52”), and wherein the secondary transaction number 102 is configured to facilitate a plurality of transactions (see e.g. col. 7, lines 32-58).

Stein further discloses said method retrieving transaction information from a database, for instance the front end storage device 58, which is accessed by front end computer program 90, or the back end storage device 72, which is accessed by back end computer program 92 (see col. 5, lines 40-54); and

replacing the primary account number with the secondary transaction number in order to initiate a second party inquiry (e.g. a “chargeback-notification message” from front end program 90), which references the secondary transaction number (see col. 11, line 54 – col. 12, line 7), and does not include the primary account number.

To summarize, the method for any transaction disclosed by Stein includes storing a customer's credit card account information in the back end storage device 72. This

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account information is assigned a "cardnumber 102," which represents but does not disclose the credit card account information to the front end system, or to a seller (see col. 5, lines 9-13 and 40-67). The chargeback process is associated with a payin notification message that includes cardnumber 102 (see col. 11, lines 54-67).

Throughout the chargeback process, the front end system and the seller reference only the cardnumber 102-B of the customer, not the customer's credit card account information.

In regard to claim 2, Stein further discloses:

determining if a valid approval code ("willingness indication") is associated with the secondary transaction number (see col. 8, lines 10-17); and

charging back to the second party an amount of the disputed transaction, if a valid approval code is not associated with the secondary transaction number (see col. 8, lines 57-67).

In regard to claims 4-6, *insomuch as understood in view of the 35 U.S.C. § 112 rejections above*, the claims are deemed anticipated by Stein as applied to claims 1 and 2 above.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stein as applied to claims 1, 2, and 4-6 above, and further in view of US Patent No. 6,636,833 to Flitcroft et al. (hereafter Flitcroft).

In regard to claims 3 and 7, Stein discloses the limitations of claims 1 and 5 as set forth above, but does not disclose routing the disputed transactions to predefined transaction number queues based on an industry type associated with the disputed transaction. Flitcroft discloses a system and method for providing limited use numbers to credit card account holders, wherein the numbers are categorized by transaction and type of merchant for which the card can be used (see col. 23, line 58 – col. 24, line 13). It would have been obvious to one of ordinary skill in the art at the time of the invention to categorize the disputed transactions of Stein by merchant type as disclosed by Flitcroft. The motivation for doing so would be to provide a more organized means for locating transactions.

### ***Response to Arguments***

Applicant's arguments filed June 23, 2008, with respect to the Stein reference, have been fully considered but they are not persuasive. Applicant contends that "*Stein's* chargeback-notification messages fail to provide any reference to *Stein's* 'cardnumber 102B,' nor any other account number." To the contrary, the Stein reference discloses a secondary transaction number replacing the primary account number so that a second party inquiry can be made, which inquiry references the secondary transaction number.



The secondary transaction number of Stein is the cardnumber 102B. When a second party inquiry is initiated, for instance when a buyer “disputes a charge on his credit card statement,” the inquiry leads to a “chargeback” (col. 11, lines 55-61). A chargeback results from “a funds transfer associated with a previous payin-notification message.” (Id.) Accordingly, when the buyer disclosed by Stein disputes a charge, he references the previous payin-notification message 212, which includes the cardnumber 102B (see FIG. 6J). This meets the limitations of claim 1, which require the inquiry to “reference[] the secondary transaction number . . . ”

It is also noted that the “payin-chargeback notification” message itself disclosed by Stein includes an ellipsis (see FIG. 6L), suggesting that the notification contains more than the notification-identifier 144 and the transfer amount 134. The Examiner contends that it would be obvious that the notification itself also include the cardnumber 102B, so that the cardholder account can be quickly identified when handling a chargeback. This would also be obvious in view of the fact that many of the data messages transferred according to the system and method of Stein include the cardnumber 102B (see FIGS. 6A-6D, 6J, 6K, 6Q).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JARED W. NEWTON whose telephone number is (571)272-2952. The examiner can normally be reached on M-F 8-5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/  
Supervisory Patent Examiner, Art Unit 3693

JWN  
September 30, 2008

<b>Application Number</b> 	<b>Application/Control No.</b>	<b>Applicant(s)/Patent under Reexamination</b>	
	10/709,978	BRECK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JARED W. NEWTON	3693	